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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,112	06/14/2001	Frederick F. Becker	UTXC:626US/MCB	7970

7590 03/25/2004
FULBRIGHT & JAWORSKI L.L.P.
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EXAMINER

DO, PENSEE T

ART UNIT PAPER NUMBER

1641

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/883,112	Applicant(s) BECKER ET AL.	
	Examiner Pensee T. Do	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 20 and 22 is/are rejected.
- 7) ☒ Claim(s) 21 and 23 is/are objected to.
- 8) ☒ Claim(s) 24-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The response filed on December 22, 2003 has been acknowledged and entered.

Withdrawn Rejection(s)

Rejection under 103 (a) is withdrawn herein.

Maintained Rejection(s)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19, 20, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ewart et al. (US 5,922,537).

Ewart teaches an assay method, sandwich, indirect, competitive or direct assay, using reporter particles such as dielectric particles (see col. 4, lines 6-14). The core particles can be made from a wide variety of inorganic materials including metals such as gold, silver, platinum (see col. 5, lines 17-26). The particle core can be encapsulated in a polymer such as polystyrene (see col. 7, lines 20-30). The dielectric particles can be engineered to have one or more dielectric properties or paramagnetic properties and phosphorescent properties (see col. 11, lines 7-13). In the assay, the target analyte is contacted with the reporter particles linked to a recognition molecule that specifically binds the target analyte. Detection is performed by comparison of the dielectric constant of unbound dielectric particles/labels and that of the complexed dielectric

particles/labels using a biosensor to measure those properties. (see col. 4, lines 53-65). The dielectric particles/labels contributes the dominant dielectric constant (second dielectric property) in the complex analyte-recognition molecule-dielectric label (see col. 14, lines 33-38). The dielectric property of an unbound dielectric label is the first dielectric property. The recognition molecule/linking element comprises of antibody, hormone, antigen, etc. (see col. 7, lines 54-65). The sample is bodily fluid such as blood (see col. 4, lines 49-51). Ewart also teaches that the dielectric particles/labels move in an electrophoretic field when being applied in a separation method (see col. 11, lines 27-31). Trapping is performed when the particles captures the analyte. Sorting is the same as separating.

Response to Arguments

The arguments filed on December 22, 2003 have been fully considered but not found persuasive.

Regarding the 35 USC 102 rejection anticipated by Ewart, Applicants clarifies that the "complex" claimed in the present invention comprises of a combination of a particle and a target. Applicants still maintain the arguments that Ewart fails to teach detection of the complex by distinguishing between the first and second dielectric properties. Applicants argue that in Ewart, a change in capacitance is being determined exclusively by a change in dielectric constant of particles to the dielectric constant of water.

Ewart recasts the theory of Newman and Bataillard, which relates measurement of capacitance change to the change in effective dielectric constant (equivalent to the

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first dielectric property of the unbound dielectric particles), and effective thickness of the dielectric layer upon complex formation between analyte and the recognition molecule (equivalent to the second dielectric property of the complex), in terms of dielectric particles. Thus, Ewart satisfies the requirement of the present invention to detect the complex by distinguishing between the first and second dielectric properties.

Allowable Subject Matter

Claims 23-35 are free of prior arts.

Claims 21, 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 571-272-0819. The examiner can normally be reached on Monday-Friday, 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-0819 for regular communications and 703-746-5291 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

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Pensee T. Do
Patent Examiner
March 13, 2004

A handwritten signature in black ink, reading "Christopher L. Chin". The signature is written in a cursive style with a large, stylized 'C' and 'L'.

CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800 1641